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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,716

06/26/2006

Frantz D. Stanford

124588.98149

7941

26710 7590 11/04/2008

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EXAMINER

GIBSON, RANDY W

ART UNIT

PAPER NUMBER

2841

MAIL DATE

DELIVERY MODE

11/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,716	Applicant(s) STANFORD, FRANTZ D.	
	Examiner Randy W. Gibson	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 22 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 6, 17 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8 September 2008 have been fully considered but they are not persuasive. Applicant argues that the preamble of claim 1 "gives life and meaning" to the body of the claim, and therefore must be considered to be limiting in the patentable sense, because the preamble mentions in passing a limitation that is found in dependent claim 5. This argument seems to be stretching the holding of *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, as the judge most likely was referring to the preamble of a claim referring to limitations found in the same claim. Even if not, then it would seem that the preamble of claim 1 "breathes life and meaning" into claim 5 only, not claim 1, or any other claim in between.

Applicant's argument that the piston 31 of Shipley is "...not of the type of cylinder and piston contemplated", seems irrelevant, as limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant should have amended the claims to expressly state what type of cylinder and piston were contemplated if he intended for the claims to be interpreted to only cover a certain type of cylinder..

Applicant's arguments that the display of Shipley does not expressly disclose a "spring" as called for in claim 6, even if true, seems irrelevant as dial indicators need some way of biasing the pointer toward zero reading in order to return the indicator to its

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original position when the pressure in the system is removed. Usually a coiled biasing spring is included in the indicator dial to return the pointer to its original position.

Applicant also argues that the drum rotating indicator of Mickelson is not “a display including a scale and enclosing an indicator”, without explaining why not. Arguing that a drum rotation “indicator” is not an “indicator” as called for in the claims seems to be a contradiction in terms. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The applicant also argues that the examiner's statement of motivation for combining the teaching of the Schneider and Nakanishi references is “both confusing and conclusory”. Since the applicant did not explain what was so confusing about the rejection, the only reply that the examiner can give is to note that: (i) any conclusion, when taken alone & out of context, is naturally going to seem “conclusory”; and, (ii) if applicant finds the statement “ar[t] recognized functional equivalence” to be unfamiliar, then he should consult *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988), and **MPEP** § 2144.07.

Applicant also argues that claim 15 requires “linkages” which transfers a fluid medium, and that the examiner did not address this limitation. A close inspection of the rejection in the last office action indicates that the examiner pointed out that Nakanishi disclosed a “fluid linkage”.

Applicant argues that the preferred embodiment of Nakanishi uses an electronic level, instead of a mechanical one, therefore it does not teach the missing elements. The examiner notes that the courts have held that “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). Information concerning background art or non-preferred embodiments, is still evidence of what one of ordinary skill in the art knew at the time. In addition, the examiner notes that disclosed examples and preferred embodiments do not in of itself constitute a teaching away from a broader disclosure or non-preferred embodiments, as applicant seems to be contending. See *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); and, **MPEP** § 2123. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

In response to applicant's argument that the reference to Schneider shows electronic clinometers instead of mechanical indicators, the examiner notes that it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that the “spring” called for in claim 19 is not expressly shown; even if true, the examiner notes that there has to be some way of biasing the indicator toward zero so that it returns to its initial reading when pressure is removed from the system. Springs are normally used for this purpose.

Some of applicant’s arguments regarding limitations found in some of the dependent claims are persuasive, however, and are discussed below.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepley (US # 3,126,069). Shepley has a position indicator consisting of a piston (31) in a cylinder (32), a hydraulic linkage (36), and an indicator (38). With respect to the claims that recite a “cable”, Shepley discloses an embodiment with a cable (Col. 3, lines 38-57). The functional language in the preamble of claim 1 that this is a “lift measurement system” is deemed to carry no patentable weight since it seems to define no structure. See ***MPEP*** § 2111.02.

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2. Claims 1 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Mickelson et al (US # 4,098,221). Mickelson discloses a lift measurement system (Abs.) consisting of a position indicator (Fig. 4) consisting of a piston (61) in a cylinder (60), a hydraulic linkage (62), and an indicator (50) which consists of another cylinder (63) and a piston (58). With respect to the dependent claims that recite a "cable", Mickelson discloses an embodiment with a cable (Col. 3, lines 8-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 15, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US # 5,890,721) in view of Nakanishi et al (US # 4,894,924). Schneider disclose a support system for performing lift operations

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comprising first and second lifting systems, each of which includes a cylinder and a piston (Col. 4, lines 19-28). Schneider also discloses a level indicator to give an operator and the control system an indication of load indication, but it is not of the structure claimed. Nakanishi disclose that it is known to construct level indicators by attaching fluid filled cylinders near the supports of a structure. Nakanishi further disclose that these cylinders each have a piston and a fluid linkage between them. It would have been obvious to use the level indicating system of Nakanishi with the hydraulic jack lifting system of Schneider motivated by its art recognized functional equivalence.

Conclusion

Claims 6, 17 and 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 21 and 22 are allowable over the art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy W. Gibson
Primary Examiner
Art Unit 2841

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